



IPW

Docket No. 740756-2688

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Etsuko ASANO et al.)
Application No. 10/735,627) Art Unit:
Filing Date: December 16, 2003) Confirmation No. 2662
For: AN EVALUATION METHOD USING A TEG,)
A METHOD OF MANUFACTURING A)
SEMICONDUCTOR DEVICE HAVING THE)
TEG, AN ELEMENT SUBSTRATE AND A)
PANEL HAVING THE TEG, A PROGRAM)
FOR CONTROLLING DOSAGE AND A)
COMPUTER-READABLE RECORDING)
MEDIUM RECORDING THE PROGRAM) Date: October 27, 2004

**PETITION REGARDING NOTICE OF OMITTED ITEMS IN A NON-
PROVISIONAL APPLICATION**

U.S. Patent and Trademark Office
220 20th Street, South
Customer Window, Mail Stop Missing Parts
Crystal Plaza Two, Lobby, Room 1B03
Arlington, Virginia 22202

Sir:

In response to the Withdrawal of Previously Sent Notice and the Notice of Omitted Items in a Nonprovisional Application dated September 2, 2004, Applicants respectfully submit that the allegedly omitted items listed in the Notice of Omitted Items, were in fact deposited at the U.S. Patent and Trademark Office (USPTO) on December 16, 2003, albeit in Japanese language.

In reviewing the transactional history of this application, Applicants note the following:

- (1) December 16, 2003: Utility Patent Application containing a complete Japanese language specification was filed at the USPTO.

- (2) April 27, 2004: Notice to File Missing Parts of Non-Provisional Application mailed, requiring an English language translation of the specification and a statement that the translation is accurate (as well as a requirement for replacement drawings).
- (3) July 27, 2004: Applicants file Response to Notice to File Missing Parts of Non-Provisional Application with a petition for extension of time, a substitute specification with marked up copy and a verification of translation w/English language specification and drawings (that inadvertently omitted translations of Figs. 8 and 9).
- (4) September 2, 2004 Withdrawal of previously Sent Notice and Notice of Omitted Items in a Non-Provisional Application mailed.

Applicants respectfully submit that the entirety of the application including specification, claims and drawings were received at the U.S. Patent and Trademark Office on December 16, 2003 (as evidenced by the copy of the date-stamped postcard attached). However, when Applicants filed the Response to the Notice of Missing Parts, Figures 8 and 9 were inadvertently omitted. Additionally, Applicants submit that upon a review of the filed translation in PAIR, no other pages of the specification appear to be missing.

In any event, Applicants provide herewith the following:

- English translation of the specification (including all specification pages, claims and abstract)
- Substitute Specification
- Application Data Sheet
- Marked-up Version of the Substitute Specification
- Replacement Drawings (Figs. 1-9) in compliance with 37 CFR 1.84 and 37 CFR 1.121

The enclosed English translation is an accurate translation of the specification as filed in compliance with 37 CFR 1.52(d). Further enclosed is a Substitute Specification in compliance with 37 CFR 1.125, including replacement claims commencing on a separate sheet in compliance with 37 CFR 1.75(h) and 1.121. The enclosed marked-up version of the Substitute Specification indicates the changes from the original specification as filed. The

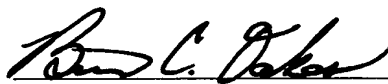
Substitute Specification contains no new matter and is being submitted to place the specification in traditional US Patent Application format. Furthermore, the enclosed replacement drawings have been amended to eliminate any non-English markings in compliance with 37 CFR 1.84(p)(2) and 37 CFR 1.52(d)(1).

Accordingly, Applicants submit that this application be accorded the filing date of December 16, 2003.

Because this application remains in the extended period from the original mailing date of the Notice to File Missing Parts of Nonprovisional Application, any necessary extensions of time may be charged to Deposit Account No. 19-2380 as well as any fees or surcharges (including additional claim/independent claim fees, foreign language surcharges and petition fees) so that this submission may be considered a supplemental response to the Notice to Missing Parts, if necessary.

Also enclosed is the requisite Petition Fee of \$130.00. The Commissioner is hereby authorized to charge any fees connected with this filing which may be required now, or credit any overpayment to Deposit Account No. 19-2380.

Respectfully submitted,



Brian C. Oakes

Registration No. 41,467

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

This will acknowledge receipt of the following:

1. Utility Application Transmittal
2. Application Data Sheet
3. 17 pages of Japanese Language specification, claims and abstract
4. 9 Sheets of Formal Drawings (Figures 1-9)
5. Original Executed Declaration and Power of Attorney
6. Original Executed Assignment Document and Recordation Form Cover Sheet
7. Certified Copy of Japanese Priority Application No. 2002-364411
8. Information Disclosure Statement w/PTO Form-1449 and references
9. Permission to charge Deposit Account No. 19-2380 in the amount of \$810.00; representing (\$770 Filing Fee, \$40 Assignment Recordation Fee)

In re the New Utility Patent Application of: Etsuko ASANO et al.

Based On Japanese Application 2002-364411 Filed: December 16, 2002

For: AN EVALUATION METHOD USING A TEG, A METHOD OF MANUFACTURING A SEMICONDUCTOR DEVICE HAVING A TEG, AN ELEMENT SUBSTRATE AND A PANEL HAVING THE TEG, A PROGRAM FOR CONTROLLING DOSAGE AND A COMPUTER-READABLE RECORDING MEDIUM RECORDING THE PROGRAM

Docket No. 740756-2688

Due Date: 12/16/2003

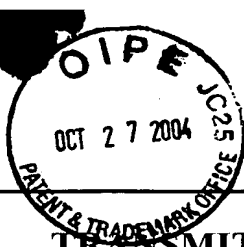
JLC/rmg

Attorney No. 8683

Date: December 16, 2003

HANDCARRY





TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	10/735,627		
	Filing Date	December 16, 2003	
	First Named Inventor	Etsuko ASANO et al.	
	Group Art Unit	2812	
	Confirmation No.	2662	
Total Number of Pages in This Submission		Attorney Docket Number	740756-2688

ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input checked="" type="checkbox"/> Drawing(s) <input type="checkbox"/> Declaration and Power of Attorney <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Application Data Sheet <input type="checkbox"/> Request for Corrected Filing Receipt with Enclosures <input type="checkbox"/> A self-addressed prepaid postcard for acknowledging receipt <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): (1) Verification of Translation w/English Language Specification and Drawings (2) Substitute Specification w/marked-up copy
Remarks		<input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees required or credit any overpayments to Deposit Account No. 19-2380 for the above identified docket number.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Brian C. Oakes Nixon Peabody LLP 401 9 th Street, N.W. Suite 900 Washington, D.C. 20004-2128
Signature	
Date	October 27, 2004

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

- ☐ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop _____, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450
- ☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) _____

Date

Signature

Typed or printed name

FEE TRANSMITTAL FOR FY 2004

Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

Complete if Known	
Application Number	10/735,627
Filing Date	December 16, 2003
First Named Inventor	Etsuko ASANO et al.
Examiner Name	2662
Art Unit	2812
Attorney Docket No.	740756-2688

TOTAL AMOUNT OF PAYMENT \$1,168.00

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number 19-2380 (740756-2688)

Deposit Account Name Nixon Peabody LLP

The Commissioner is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
1001	790	2001	395	Utility filing fee	
1002	350	2002	175	Design filing fee	
1003	550	2003	275	Plant filing fee	
1004	790	2004	395	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) \$

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
	-20** =	X	=
Independent Claims	-3** =	X	=
Multiple Dependent	X	=	=

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description
1202	18	2202	9	Claims in excess of 20
1201	88	2201	44	Independent claims in excess of 3
1203	300	2203	150	Multiple dependent claim, if not paid
1204	88	2204	44	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) \$1,168.00

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description
1051	130	2051	65	Surcharge - late filing fee or oath
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet
1053	130	1053	130	Non-English specification
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action
1251	110	2251	55	Extension for reply within first month
1252	430	2252	215	Extension for reply within second month
1253	980	2253	490	Extension for reply within third month
1254	1,530	2254	765	Extension for reply within fourth month
1255	2,080	2255	1,040	Extension for reply within fifth month
1401	340	2401	170	Notice of Appeal
1402	340	2402	170	Filing a brief in support of an appeal
1403	340	2403	150	Request for oral hearing
1451	1,510	1451	1,510	Petition to institute a public use proceeding
1452	110	2452	55	Petition to revive - unavoidable
1453	1,370	2453	685	Petition to revive - unintentional
1501	1,370	2501	685	Utility issue fee (or reissue)
1502	490	2502	245	Design issue fee
1503	660	2503	330	Plant issue fee
1460	130	1460	130	Petitions to the Commissioner
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)
1806	180	1806	180	Submission of Information Disclosure Stmt
8021	40	8021	40	Recording each patent assignment per property (times number of properties)
1809	790	2809	395	Filing a submission after final rejection (37 CFR 1.129(a))
1810	790	2810	395	For each additional invention to be examined (37 CFR 1.129(b))
1801	790	2801	395	Request for Continued Examination (RCE)
1802	900	1802	900	Request for expedited examination of a design application

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) \$130.00

SUBMITTED BY

Name (Print/Type)		Registration No.		Complete (if applicable)	
Brian C. Oakes		41,467		Telephone	(202) 585-8000
Signature		(Attorney/Agent)		Date	October 27, 2004

SEND TO: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450